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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,755	07/26/2001	James W. Barnettler	10004604-1	9081

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HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

QUELER, ADAM M

ART UNIT	PAPER NUMBER
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2179

DATE MAILED: 05/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/916,755	<b>Applicant(s)</b> BARMETTLER, JAMES W.	
	<b>Examiner</b> Adam M Queler	<b>Art Unit</b> 2179	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 February 2005.  
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.  
4a) Of the above claim(s) 9-16 and 25-32 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-8 and 17-24 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

*hc*

### **DETAILED ACTION**

1. This action is responsive to communications: Amendment filed 2/17/2005.
2. Claims 1-32 are pending in the case. Claims 1, 9, 17, and 25 are independent claims. Claims 9-16 and 25-32 withdrawn from further consideration

#### ***Election/Restrictions***

3. Applicant's election without traverse of group I in the reply filed on 02/17/2005 is acknowledged.
4. Claims 9-16 and 25-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 2/17/2005.

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-8 and 17-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no definition of "passing an named tag element for a desired portion into a desired portion." For clarity's sake "named tag element" is understood and not at issue. "Passing" is understood in terms of passing parameters, however, at the time of the invention it was not clear how one would pass an element into a portion. "Portion" is not defined either. While Applicant clearly

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means a region on the page, how does one pass an element, which itself is a region, into another. Is it a new portion, or a range falling between existing element tags? Is the named tag element a new tag? Furthermore, the interrelationship of "element for a desired portion" is not understood. Applicant has not provided any examples of what these aspects of the claims mean in relation to a document tree or even the HTML code itself. As such, these terms are not defined, one of ordinary skill in the art would certainly have to undergo undue experimentation in response to Applicant's disclosure.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claims 1-8, and 17-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 1 (and substantially 17) recites "passing a named tag element for the desired portion into the desired portion of the web page." As explained above, there is no support in the specification for such language. As a result the scope of the claims are indeterminate. Claims 2-8 and 17-24 are rejected for incorporating the same deficiency.

Claim 4 recites the limitation "the scripting language" in line 1. There is insufficient antecedent basis for this limitation in the claim. For examining purposes only it will be assumed that the claim is meant to depend on claim 3.

Claim 17 recites the limitation "the named tag element" in line 8. "Named tag element" has not been used in the claim.

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The multiple deficiencies in the claim noted above, render the scope of the claims to indeterminate. Therefore, for examining purposes only, the previous art rejections are repeated. Although, the amendment appears to amend around the prior art, the indeterminate scope, as explained above, renders it impossible to ascertain whether or not it does overcome the rejections, as well making a new search impossible.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 1-3, 5-8, 17-19, and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shima (US 20030035144A1, filed 5/18/2001).**

**Regarding independent claim(s) 1**, Shima teaches a named tag element for the desired portion around the desired portion of the web page (para. 45, ll. 8-9). Shima teaches querying the named tag portion and extracting the text (para. 13, ll. 6-7). Shima teaches extracting to a new document (para. 13, ll. 7-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to open this document, thereby opening a browser window and sending the text there, because an HTML document is well-known in the art to be viewed in a browser.

Shima teaches printing (para. 15, ll. 7-9).

**Regarding independent claim(s) 17**, Shima teaches a mechanism for invoking a script that calls a print function (para. 46, ll. 5-7). Shima teaches a named tag element for the desired portion around the desired portion of the web page (para. 45, ll. 8-9). Shima teaches querying the named

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tag portion and extracting the text (para. 13, ll. 6-7). Shima teaches extracting to a new document (para. 13, ll. 7-8). It would have been obvious to one of ordinary skill in the art at the time of the invention to open this document, thereby opening a browser window and sending the text there, because an HTML document is well-known in the art to be viewed in a browser.

Shima teaches printing (para. 15, ll. 7-9).

**Regarding dependent claim(s) 2 and 18**, Shima teaches a script (para. 46, ll. 5-7).

**Regarding dependent claim(s) 3 and 19**, Shima does not teach using a scripting language. SSJ teaches using a scripting language (p.2, para 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Shima and SSJ to use JavaScript to open the window, in order to offload processing to the client (Table 4.1).

**Regarding dependent claim(s) 5 and 21**, Shima does not teach additional downloading, and therefore must send the stream before the browser downloads additional content to the user's computer.

**Regarding dependent claim(s) 6 and 22**, Shima does not teach a plug-in, therefore must send the stream before the browser installs plug in routines.

**Regarding dependent claim(s) 7 and 23**, Shima does not teach an executable, therefore must send the stream before the browser installs executable programs.

**Regarding dependent claim(s) 8 and 24**, Shima does not teach a program control, therefore must send the stream before installing a program control.

**11. Claims 4 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shima as applied to claims 3 and 19 above, and further in view of "Basics of Server-Side JavaScript, Chapter 4", (published 10/30/97), hereinafter SSJ.**

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**Regarding dependent claim(s) 4 and 20**, Shima does not teach using a JavaScript. SSJ teaches using JavaScript® (p.1, para 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Shima and SSJ to use JavaScript to open the window, in order to offload processing to the client (Table 4.1).

### ***Response to Arguments***

12. Applicant's arguments filed 05/02/2005 have been fully considered but they are not persuasive.

The multiple deficiencies in the claim noted above, render the scope of the claims to indeterminate. Therefore, for examining purposes only, the previous art rejections are repeated. Although, the amendment appears to amend around the prior art, the indeterminate scope, as explained above, renders it impossible to ascertain whether or not it does overcome the rejections, as well making a new search impossible.

### ***Conclusion***


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam M Queler whose telephone number is (571) 272-4140. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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